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09/817,978REMARKS

This amendment is in response to the Examiner's Office Action dated October 19, 2005. Reconsideration of this application is respectfully requested in view of the foregoing amendment and the remarks that follow.

STATUS OF CLAIMS

Claims 1-27 are pending.

Claims 5, 26, and 27 are hereby cancelled.

Claims 1, 3-6, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nishigaki (US 5,825,698).

Claims 1-5, 12, 14-18, 22, 23, 26, and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Horlander et al (EP 09139947).

Claim 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishigaki (US 5,825,698) in view of Obitsu (US 6,650,376).

Claims 7-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishigaki (US 5,825,698) in view of Dagtas et al (US 2002/00800286).

Claims 7-11 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horlander et al (EP 0913997) in view of Dagtas et al (US 2002/00800286).

Claim 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horlander et al (EP 0913997) in view of Yuen et al (US 6,091,882).

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09/817,978In the Specification

A typographical error was corrected on page 4 as the term "permit" was duplicated. No new matter was added.

In the Claims

Please note rejections to cancelled claims 5, 26, and 27 are deemed moot and will not be directly addressed.

REJECTIONS UNDER 35 U.S.C. § 102 (b)

To be properly rejected under 35 U.S.C. §102, each and every element of claims must be disclosed in a single cited reference. The applicants, however, contend that the presently claimed invention cannot be anticipated in view of the Nishigaki et al. (hereafter Nishigaki) and Horlander et al. (hereafter Horlander) references, singularly or in combination. Applicant believes that Nishigaki and Horlander do not disclose many of the elements of the claims of the present invention as will be detailed below.

Claims 1, 3-6, 24, and 25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nishigaki (US 5,825,698). Nishigaki describe an apparatus for controlling a record operation based on a copy inhibit signal. The teachings of Nishigaki, however, fail to describe any mechanism to determine the operational state of a settop box. Nishigaki simply inhibit recording to prevent illegal copying. As Nishigaki is not concerned with the operational state of a settop box, they do not further provide for additional features such as notifying a settop provider of settop operation, monitoring operation of settop box with an antenna and resulting alarm signal, monitor settop box operability based on changing video signal. In addition, no use of electronic messages to a settop provider is disclosed, nor suggested by Nishigaki. Claim 27 was not cited by

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the rejection, but was included in the arguments of the examiner. Clarification is not needed as this claim has been cancelled.

As many of the features are not disclosed, nor suggested by Nishigaki, the rejection of claims based on Nishigaki should be removed and the claims passed to issue.

Claims 1-5, 12, 14-18, 22, 23, 26, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horlander (EP 09139947). Please note that the examiner has cited page and line numbers for this European patent application, however, the reference is labeled by paragraph, with no page numbers, making correlation with examiner citations difficult. In addition, claim 15 was rejected but no discussion was provided by the examiner (as is required). It appears, based on a later 103 rejection of claim 15, that this rejection was made in error.

Horlander is directed to operating a digital video recorder in one of a digital or analog recording mode based on fault conditions. Horlander teaches that the recorder operates in either the digital mode through DSS 170 or through antenna 140. The digital video recorder of Horlander appears to monitor its own state and combines user input to determine proper recording modes. The DSS appears to monitor the digital video recorder's status to determine before sending a digital signal. As Horlander is focused on recording either a digital or analog signal and determining when to switch, they do not disclose determining settop box operability based on monitoring an input port of a programmable TV recorder. In addition, no disclosure of features such as notifying a settop provider (control facility) of settop operation, monitoring operation of settop box with an antenna, monitoring settop box operability based on changing video signal, or a sensor to monitor on-off state of a settop box exists within Horlander. The examiner should not confuse soliciting user input to determine recording actions with notifying a settop provider of settop box operability. Nor should contacting the user be confused with contacting a settop box provider. For example, if the user was not home and the DSS failed, the

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user would not be there to assist with recording decisions. However, the presently claimed invention could intervene without user assistance by either preventing recording or trying corrective action directly or through the settop box provider (control facility). And finally, as no settop provider is notified, no use of electronic messages to a settop provider is disclosed by Nishigaki.

As stated above, to be properly rejected under 35 U.S.C. §102, each and every element of claims must be disclosed in a single cited reference. The applicants, however, contend that the presently claimed invention cannot be anticipated in view of Nishigaki and Horlander, singularly or in combination, based on the many missing features not disclosed nor suggested by the references.

REJECTIONS UNDER 35 U.S.C. § 103 (a)

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishigaki (US 5,825,698) in view of Obitsu (US 6,650,376). As previously cited, Nishigaki fails to disclose or suggest a programmable TV recorder monitoring the operational state of a settop box; therefore there would be no motivation, suggestion, or teaching to add the Obitsu reference's teaching of determining if an antenna is properly attached. Specifically, Nishigaki monitors copy protection codes with no teaching of monitoring a separate device's operability. Even if the references could be properly combined, they still would not produce a programmable TV recorder that monitored the operability of a settop box with an antenna.

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Claims 7-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishigaki (US 5,825,698) in view of Dagtas et al (US 2002/00800286). As previously cited, Nishigaki fails to disclose or suggest a programmable TV recorder monitoring the operational state of a settop box. The Dagtas reference teaches locating program boundaries. The examiner has put forth no reasonable argument as to how the teachings of Dagtas (locating program boundaries (commercials)) combined with Nishigaki's discovering copy protect codes would provide the claimed programmable TV recorder that monitors the operability of a settop box. It is suggested that the combination would simply find program boundaries and/or copy protect codes.

Claims 7-11 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horlander et al (EP 0913997) in view of Dagtas et al (US 2002/00800286). As previously cited, Horlander fails to disclose or suggest a programmable TV recorder monitoring the operational state of a settop box. The Dagtas reference teaches locating program boundaries. The examiner has put forth no explicit argument as to how the teachings of Dagtas (locating program boundaries (commercials)) combined with Horlander would provide the claimed programmable TV recorder that monitors the operability of a settop box. More specifically, Dagtas locates a program boundary based on audio classification. Nowhere is a discussion of monitoring various video signal portions, frame-to-frame changes, and/or audio signals within a received signal to indicate the operational state of a settop box. No nexus exists between locating commercials and settop box operability, nor is one given by the examiner.

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Horlander et al (EP 0913997) in view of Yuen et al (US 6,091,882). The examiner has added Yuen to compensate for Horlander not disclosing a sensor disposed proximate to a settop box. However,

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a close reading of column 19, lines 5-37, simply reveals discussion of a stand to align IR diodes to enable programming. Nowhere, either singularly or in combination, is a teaching or suggestion of using a sensor to indicate the on/off status of a settop box.

### SUMMARY

As has been detailed above, none of the references, cited or applied, provide for the specific claimed details of applicant's presently claimed invention, nor renders them obvious. It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested.

As this amendment has been timely filed within the set period of response, no petition for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided to Deposit Account No. 12-0010.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicant's representative at the below number.

Respectfully submitted,



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January 18, 2006